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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,887	02/09/2001	George A. Pecoraro	1657A1	9023

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EXAMINER

BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 12/04/2002

78

Please find below and/or attached an Office communication concerning this application or proceeding.

AS7

Office Action Summary	Application No. 09/780,887	Applicant(s) PECORARO ET AL.	
	Examiner Elizabeth A. Bolden	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election of Group II in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group I, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is indefinite for failing to further limit the claim from which it depends, claim 19. Claim 19 recites a limitation "CaO + MgO from 12 to less than 13.4 weight percent", wherein depending claim 17 recites a limitation "CaO + MgO from 12 to 13.5 weight percent". This range is broader than the claim from which it depends rendering claim 17 indefinite.

Applicant is advised that should claim 20 be found allowable, claim 21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing,

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despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 14-24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morimoto et al., U.S. Patent 5,362,589.

Morimoto et al. disclose an infrared and ultraviolet ray absorbing glass. The glass contains the following components in weight %: SiO₂ 68-72%, Al₂O₃ 1.6-3.0%, CaO 8.5-11%, MgO 2-4.2%, Na₂O 12-16%, K₂O 0.5-3%, SO₃ 0.08-0.3%, Fe₂O₃ 0.58-0.8%, CeO₂ 0.10-0.60%, and TiO₂ 0.10-0.4%. See abstract Morimoto et al. The compositional ranges of Morimoto et al. are sufficiently specific to anticipate the glass recited in claims 14-24. See MPEP 2131.03. Moreover, Examples 2, 4, and 5 of Morimoto et al. anticipate the glass composition recited in one or more of claims 14-24. Examples 2, 4, and 5 have CaO to MgO ratios of 3.8, 2.52, and 2.6, respectively.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Morimoto et al. would inherently have the same properties as recited in claims 19-21, 23, and 24. See MPEP 2112.

Claim 22 defines the product by how the product was made. Thus, claim 22 is product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat or float glass. The reference suggests such a product. See column 1, lines 9-15 of Morimoto et al.

Claims 14-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Nakashima et al., U.S. Patent 6,313,052 B1.

Nakashima et al. discloses that a glass substrate contains the following compounds in weight %: SiO₂ 62-74%, Al₂O₃ 1-15%, CaO 0-14%, MgO 0-9%, Na₂O 0-12%, K₂O 0-13%. See the abstract of Nakashima et al. These ranges are sufficiently specific to anticipate the compositional limitations recited in claims 14-24. See MPEP 2131.03. Moreover, example 20 anticipates the glass in claims 14-24. Example 20 has a CaO+ MgO content of 12 wt% and a CaO to MgO ratio of 3.8.

Since applicants compositions is taught by Nakashima et al. it follows that properties recited in claims 19-21, 23, and 24 would be inherent in the compositions of Nakashima et al. See MPEP 2112.

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Claim 22 defines the product by how the product was made. Thus, claim 22 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat or float glass. The reference suggests such a product. See column 3, lines 7-10.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14-21, 23, and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-31 of copending Application No. 09/974,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because the glass of U.S. Patent application 09/974,124 has overlapping compositional ranges with the glass of the present claims. See claims 17-31 of 09/974,124.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Duplicate Claim - 35 USC § 103(a)/102(f)(g)

Claims 14-21, 23, and 24 are directed to an invention not patentably distinct from claims 17-31 of commonly assigned U.S. Patent Application 09/974,124. Specifically, the glass of U.S. Patent application 09/974,124 has overlapping compositional ranges with the glass of the present claims. See Table 1 on page 11 of 09/974,124.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302).

Commonly assigned U.S. Patent application 09/974,124, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

Applicant's arguments filed 9 September 2002 have been fully considered but they are not persuasive.

Applicants assert that Morimoto et al. and Nakashima et al. do not have the claimed CaO+ MgO content and the claimed CaO/MgO ratio. This argument is not deemed persuasive. As Noted in the rejections above, the references disclose the claimed CaO+MgO content and the claimed CaO/MgO ratios. Applicants assert that the examiner has not provided extrinsic evidence to prove that the claimed properties are inherent to the glasses of the references. The examiner's understanding of inherency is derived from MPEP 2112. This section states:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

In the present case, the technical reasoning flows from the fact that "products of identical compositions cannot have mutually exclusive properties." See MPEP 2112.01. (Citing in re Spada, 15 PQ2d 1655, 1658 (CCPA 1990)). In other words, the compositions of the references fall squarely within the presently claimed compositional ranges and therefore these compositions must have the same properties as those claimed.

The examiner further notes that MPEP 2112 states that:

"[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

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Applicants further assert that the “certain thing” (in this case the properties) does not flow naturally from the references. The examiner disagrees. The ‘certain thing’ flows from the reference because, again, identical compositions must have the same properties. MPEP 2112

Applicants assert that there is no conflict in claims 14-21, 23, and 24 of the instant application and in the claims 17-31 of copending application U.S. 09/974,124 since the claims of the instant application are directed at the ratio of CaO to MgO and the combined amount of those two components. The copending application does not have claim limitations specifically directed at the CaO and MgO components cumulative content and the ranges of the ranges of the content of the components. The ranges for the components are sufficiently specific to render obvious the combined content and the ratio of CaO to MgO is obvious from the ranges of the components both alone and in combination to render obvious the range of the ratio. See MPEP 2141.05.

The 35 U.S.C. 102(b) rejection over Jeanvoine et al. U.S. Patent 5,700,579 is withdrawn.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 7:30am to 5:00 pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


DAVID SAMPLE
PRIMARY EXAMINER

EAB
December 2, 2002